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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,009	08/25/2003	Amlan Datta	129843.1104	3329

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EXAMINER	
MARCANTONI, PAUL D	
ART UNIT	**PAPER NUMBER**
1755	

MAIL DATE	DELIVERY MODE
06/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/648,009	DATTA ET AL.	
	Examiner	Art Unit	
	Paul Marcantoni	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,6 and 12-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5,6, and 12-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 5/25/07
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The applicants' 4/2/07 response has been considered but is unpersuasive.

Provisional ODP

Claims 1,5, 6, and 12-15 remain provisionally rejected on the grounds of non-statutory obviousness type double patenting as being unpatentable over claims 1-27 and 1-15 of copending application nos. 2004/0081827 A1 (Datta et al.) and 2004/0079260 A1 (Datta et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a composition comprising microspheres that overlap the composition of one another. Overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art. Further, the applicants' new intended use of a known composition in their claims 12-15 is not a patenable distinction. The new use of a composition that is already known is not patentable.

ODP-Now Withdrawn

The ODP over Gleeson '697 has been withdrawn because Gleeson '697 teaches his microspheres used for his building material are fly ash cenospheres. The amount of CaO for fly ash cenospheres is outside applicants' higher claimed range. See Table 2, column 3, lines 1-12 of Gebhart (US Patent No. 3,782,985) who teaches a specific composition in weight percent for fly ash cenospheres. The amount of CaO in fly ash cenospheres is 0.2 to 0.6 wt% which is well below applicants claimed amount of *not less than 5.2 wt% to about 30 wt% calcium oxide.* (see applicants claim 1). This is the only reason this reference was withdrawn; the lack of overlap of CaO.

The examiner disagrees with applicants' assertions that the Gleeson (which prefers fly ash cenospheres but does not provide other examples that can be used) does not teach about 4 to 10 wt% sodium oxide or less than 2 wt% potassium oxide. First, the amount of potassium oxide can be zero or read upon zero. Second, Gleeson does teach an overlapping amount of sodium oxide (See Table 2, col.3, of Gebhart '985) with a range of sodium oxide of 0.5 to 4.0 wt%. Nevertheless, the amount of CaO differs from applicants' claims and Gleeson has been now withdrawn.

35 USC 102/103:

Claims 1,5,6, and 12-15 are rejected under 35 USC 102(b) as anticipated by, or, in the alternative, under 35 USC 103(a) as obvious over Beck et al. (3M Patent-US Patent Number 3,365,315-also listed on page 11 paragraph [0038] of applicants' specification) or Goetz et al. (US Patent Number 4,983,550).

Response:

Provisional ODP over '827 A1 (Datta et al.) and '260 A1 (Datta et al.)

Applicants state that the examiner must determine which application claims the base invention and which claims the improvement when co-pending applications are filed on same day and upon such a determination, the rejection for the base application is withdrawn (thus removing the requirement for filing a terminal disclaimer). The examiner was referred to MPEP 804. In rebuttal, it does not clear how the examiner is required to point out which application points out the base invention and which application claims the improvement. It would seem that applicants would know best (than including the examiner) the answer to this question. The examiner respectfully

asks applicants for their assistance and opinion regarding which application is the base invention and which is the improvement. The examiner cannot clarify between the two applications as to which is which. The examiner will then in turn take the next step and withdraw the base application versus the improvement application (evidently because one has to be allowed before a terminal disclaimer can be filed).

The examiner also points out that page 3, paragraphs [0054] and [0055] of Datta they teach applicants claims 1 and 6 and applicants' remaining claims are intended use claims. The new use of a known composition is not a patentable distinction.

35 USC 102/103:

Beck:

The applicants state that Beck is not really an aluminosilicate. This assertion is not understood as Beck teaches a raw material glass made from alumina and silica so it would follow that it is an aluminosilicate material. The applicants also make a statement that is not factually correct. They state that the aluminum oxide content is specifically taught *always* to be less than 1.2 wt% and they refer the examiner to the examples. In rebuttal, this statement is not correct. The aluminum oxide content can be in the range of 0 to 20 wt% (see Table I, col.4 of Beck). Further, a reference is good for all that it realistically teaches and it is not limited to the specific examples or preferred embodiments. Therefore, aluminum oxide content is not always less than 1.2 wt%. Note that applicants own claims do not even require iron oxide so the presence of iron oxide is not relevant to applicants' claimed invention. Beck teaches a range of alumina of 0 to

20 wt% thus meeting applicants' claims. This listing of amounts in Table I is very specific as well to teach Beck's invention.

The applicants make general assertions regarding reasonable doubt in the field of chemistry and re-arrangement of parts cannot support obviousness. The applicants seem to arguing that Beck cannot use his own invention. The examiner disagrees and refers applicants back to Beck's Table I in column 4 which teaches the *specific* components and amounts claimed by applicants. There is no reasonable doubt (in chemistry or any other scientific endeavor) with respect to Beck's Table 1 ranges because this is the specific teaching of the compositional analysis of what qualifies as his own invention. The applicants are also and again referred to claim 1 in column 8 for Beck wherein a particle diameter of between 5 to 300 microns is taught which overlaps applicants' claimed range of 30 to 1000 microns in their claim 1.

Goetz:

The applicants argue that Goetz does not teach microspheres having less than about 2 wt% potassium oxide and that Goetz requires 3.8 to 10 wt% of potassium oxide (col.3, lines 24-26). This statement is factually incorrect. Col.3 lines 22-23 (and claim 1), just above where applicants refer examiner, it teaches that R2O or K2O (potassium oxide) is present in the amount of between 2 and 15 wt%. Therefore, it reads upon applicants range of less than about 2 wt% potassium oxide. Note that "about" permits some tolerance and applicants lower limit of "about 2 wt% potassium oxide" can be an amount greater than the lower limit of Goetz of between 2 wt%. The applicants would be correct if they did not use " less than about 2 wt% potassium oxide" but only used

"less than 2 wt% potassium oxide" but that is not what they are presently claiming. Also, it is noted that this statement by the examiner is not a suggestion but only an observation or commentary on the present state of applicants' claims and a rebuttal to their own presented arguments.

The applicants also argue R2O3 is boron oxide. The examiner disagrees and notes that R203 is alumina and Goetz even teaches an amount of alumina or R2O3 (other than boron oxide) of 0 to 10 wt%.

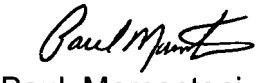
Applicants also argue examples with respect to alumina and boron oxide amount. In rebuttal, a reference is good for all that it realistically teaches and is not limited to the examples or preferred embodiments. Goetz teaches specific ranges in claim 1 of the same components and in overlapping amounts of applicants own invention and thus meets the limitations of applicants claims.

The examiner has fully addressed applicants' arguments and the finality of this office action is now proper. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373 The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755